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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/001,563

10/23/2001

Mary Theresa Murray

3087.00007

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7590

09/18/2006

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EXAMINER

ANGELL, JON E

ART UNIT

PAPER NUMBER

1635

DATE MAILED: 09/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

TH

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/001,563	Applicant(s) MURRAY ET AL.	
	Examiner Jon Eric Angell	Art Unit 1635	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 22 August 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

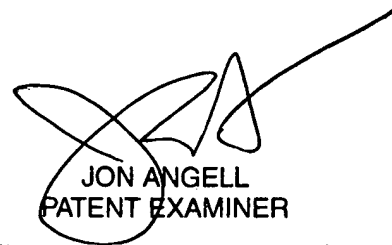
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: 45.
 Claim(s) rejected: 1,2,4,7,8,21-24,43 and 44.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.


 JON ANGELL
 PATENT EXAMINER

Continuation of 3. NOTE: Proposed claim 24 is amended to depend on claim 45. However, claim 45 is cancelled in the proposed claim listing filed 8/4/06. Therefore, proposed claim 24 is indefinite because it depends on cancelled claim 45. Since the proposed amendment would require a new grounds of rejection under 35 USC 112, second paragraph, the amendment is not entered.

Continuation of 11. does NOT place the application in condition for allowance because: Proposed claim 24 has been amended such that it no longer depends on cancelled claim 27; however, proposed claim 24 now depends on cancelled claim 45. Therefore, Applicant's argument that the claim has been amended to overcome the rejection is not persuasive as the proposed claim would require rejection under 35 USC 112, second paragraph. Furthermore, it is respectfully pointed out that should proposed claim 24 be amended such that it is not dependent on a cancelled claim, claims 1, 2, 4, 7, 8, 43 and 44 would not be allowable because the specification does not provide a disclosure that enables the full scope of these claims for the reasons indicated in the rejection of these claims under 35 USC 112, 1st paragraph (e.g., see the 5/17/05 Office Action). Specifically, claims 1, 2, 4, 7, 8, 43 and 44 encompass methods wherein the mRNA is delivered to cells that are in a subject (i.e. in vivo). Applicants indicate that the Office Action has held that if the limitation of mRNA encoding eIF-4E was inserted into the claim such an amendment would overcome the rejection (see page 6 of Applicants reply). In response, it is respectfully pointed out that the previous Office Actions indicated that amending the claims to include the limitation that the mRNA encoded eIF-4E would overcome the written description rejection of claims, not the scope of enablement rejection. It is noted that amending claims 1, 2, 4, 7, 8, 43, 44 to an in vitro method would obviate the scope of enablement rejection under 35 USC 112, 1st paragraph. It is acknowledged that the proposed amendment would overcome the rejection of claims under 35 USC 102(b); however, since the proposed amendment is not entered, the claims remain rejected under 35 USC 102. With respect to the written description rejection under 35 USC 112, first paragraph, it is acknowledged that limiting the claims to delivering a mRNA encoding eukaryotic translation initiation factor 4E (eIF-4E) would overcome the rejection as it pertains to the genus of eukaryotic translation initiators encompassed by the claims; however, the rejection of record also indicates that the specification does not provide a sufficient description of mRNAs encoding ACTIVATORS of eukaryotic translation initiators, such as in claims 7 and 23. Amending the claims such that they are drawn to mRNAs encoding activators of eIF-4E (e.g., see proposed claims 7 and 23) do not obviate this rejection because the specification does not adequately describe the genus of ACTIVATORS encompassed by the claims. To overcome the rejection as it pertains to the genus of ACTIVATORS, Applicants should indicate where the description of the genus of ACTIVATORS is described in the specification.



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